Appl. No. 10/776,150
Reply to Office Action of October 16, 2007

Attorney Docket No. 26530.94 / IDR-685
Customer No. 27683

REMARKS

Claims 1-25 are pending in this application. In view of the following remarks, reconsideration is respectfully requested. On pages 5-6 of the Office Action, the Examiner offers some comments in a "Response to Arguments" section. The Examiner's comments are addressed in the remarks below.

Comment Regarding Power of Attorney

The Power of Attorney for this application does not happen to identify the undersigned attorney. In filing this Response, the undersigned is acting under the provisions of 37 C.F.R. §1.34.

Allowable Subject Matter

Applicant notes with appreciation the indication in the Office Action that dependent Claims 4-9, 15-17 and 22 recite allowable subject matter, and would be allowed if rewritten in independent form. These allowable claims each depend directly or indirectly from one of independent Claims 1, 12, and 20. Independent Claims 1, 12, and 20 are each believed to be allowable for reasons discussed later, and it is therefore believed to be unnecessary to separately place Claims 4-9, 15-17 and 22 in independent form at this time.

Objection to Incomplete Office Action

Applicants respectfully object to the Office Action because it is not complete. More specifically, the provisions of MPEP §707.07(f) instruct examiners that:

> Where the applicant traverses any rejection, the examiner should,
> if he or she repeats the rejection, take note of the applicant's
> argument and answer the substance of it.

In the present application, the Examiner issued a prior Office Action on March 1, 2007. The March 1 Office Action rejected independent claims 1, 12, and 20 under 35 U.S.C. §103(a) based on a proposed combination of Harsham U.S. Pat. No. 6,041,347 and Nguyen U.S. Patent Application Publication No. 2003/0172145. On May 1, 2007, Applicants replied to that prior Office Action, in particular by filing a Response that traversed the rejection, and that presented arguments against the rejection. The Examiner then issued a substantially identical Office Action on June 6, 2007, but it was subsequently withdrawn. Then, on October 16, 2007, the Examiner mailed the present Office Action.

The present Office Action sets forth <u>exactly</u> the same ground of rejection that appeared in the March 1 and June 6 Office Actions, using exactly the same wording. But the present Office Action does not contain any reply to an argument presented in Applicants' last Response. In particular, page 5 of the May 1 Response argued that Nguyen does not teach "creating a new independent rule block," "inserting," or conditioning the insertion on the emptiness of a "list" as recited by the claims. This argument has been completely ignored by the Examiner.

Thus, the present Office Action repeats a §103 rejection from the last Office Action, but fails to "take note of the applicant's argument and answer the substance of it". Accordingly, it is respectfully submitted that the present Office Action is not complete, because it fails to comply with the PTO requirement set forth in MPEP §707.07(f). It is therefore respectfully submitted that the present Office Action must be withdrawn, and replaced with a new and complete Office Action that does comply with MPEP 707.07(f).

<u>Rejection of Claim 12 under 35 U.S.C. §103(a)</u>

Claim 12 stands rejected under 35 U.S.C. §103(a) based on a proposed combination of Harsham and Nguyen. This rejection is respectfully traversed.

MPEP §2143 provides "To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." Applicant respectfully submits that the Examiner has not shown how either the Harsham reference, the Nguyen reference, or both references together teach all of the claim limitations recited in claim 12. For example:

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- Claim 12 of the present application recites "ordered access rules." Paragraph 4 of the Office Action does not describe (or even use the words) "ordered access rules". It only mentions "rules which define configuration parameters." Further, the Examiner has not shown any way in which "configuration parameters" are similar to "ordered access." Without a demonstration of any sort of similarity, this is like asserting that the rules for baseball are just like the rules for football.

- Claim 12 of the present application recites creating "a set of mapped independent rule blocks" if an access control list is not empty. Paragraph 4 of the Office Action asserts that this limitation is taught by Harsham, at col. 4, lines 25-28. The cited text in Harsham states, "[a]ccordingly, in the present invention, various logical groups of individual machines and groups of machines in the computer network may be defined" (Harsham, col. 4, ll. 25-18). The Examiner has not shown how the cited section of Harsham teaches "rule blocks" that are "independent" or in a "set."

- Claim 12 of the present application recites "creating a new independent rule block" and inserting a rule therein if the access control list is empty. Paragraph 4 of the Office Action asserts that this limitation is taught by Nguyen at page 15, paragraph [0434]. The cited text in Nguyen states:

> Another consideration may be: is the design to include a router Access Control List (ACL) and packet filters? Many ISPs choose to omit firewalls and implement router ACL and packet filters instead. Considerations on whether to implement a firewall or router ACL and packet filters may include one or more of, but are not limited to, the following: routers are stateless and do not examine payload, and firewalls are necessary for stateful applications.

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There is no reasonable interpretation of the quoted language that would amount to "creating a new independent rule block," "inserting," or conditioning the insertion on the emptiness of a "list." As discussed earlier, this argument was presented in the previous Response mailed May 1, 2007, but it was not addressed in the "Response to Arguments" section of the present Office Action. Applicant is still waiting for a response to this argument.

- Claim 12 of the present application also recites "a rule base," "a rule insertion engine," "merging the blocks," and "a subset of the set comprising those blocks for which a position for the new access rule can be determined" which do not appear *anywhere* in the text of the Office Action. Further, despite the Office Action mentioning a "list," the specific term of art "access control list" does not appear anywhere in the Office Action. It is impossible for the Office Action to claim equivalence between claim 12 and any combination of Harsham and Nguyen if the Office Action does not discuss every element of claim 12.

Thus, for each of these reasons, individually and collectively, it is respectfully submitted that Harsham and Nguyen do not teach or suggest all the limitations in Claim 12 as required by MPEP §2143, even when combined in the manner suggested by the Examiner. Therefore, it is respectfully submitted that the rejection under U.S.C. § 103(a) is improper and must be withdrawn. Notice to that effect is respectfully requested.

Comments Regarding Examiner's Response to Arguments

In reply to arguments in the Response mailed May 1, 2007, the Office Action presents two assertions, which are discussed separately below.

1) A "structural difference":

The Office Action asserts that "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art," (paragraph 11a of the present Office Action). This argument fails.

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Independent claim 12 of the present application recites a "computer system" comprising an "access control list . . . configured to contain independent rule blocks." Paragraphs 4 and 11 of the present Office Action assert that this limitation is taught by Harsham, at col. 4, lines 25-28. The cited text in Harsham, states "[a]ccordingly, in the present invention, various logical groups of individual machines and groups of machines in the computer network may be defined."

A computer system programmed to perform a function is <u>structure</u> for performing that function. Even assuming that "logical groups of individual machines and groups of machines in the computer network" could somehow be equivalent to "mapped independent rule blocks," the independent rule blocks in claim 12 are contained in an "access control list." Harsham's "logical groups of individual machines and groups of machines in the computer network," however, are not contained in *anything*; instead, they are standalone entities that represent the physical or logical "topology of the network." Harsham, col. 4, lines 18-19. This lack of containment is a structural difference between Harsham and claim 12. The Office Action applies no other reference, including Nguyen, that teaches this claim limitation. For this reason alone, Harsham and Nguyen do not teach or suggest <u>all</u> the limitations in claim 12 as required by MPEP §2143, even when combined in the manner suggested by the Examiner. Thus, the rejection of claim 12 based on Harsham in view of Nguyen is erroneous and must be withdrawn.

Even assuming that there is some sort of containment in Harsham, the structure of Harsham is still distinct from claim 12 of the present application. The entities in Harsham are arranged in trees or graphs, rather than in a *list*. This is illustrated by associated Figs. 2 and 3, which show Harsham's "logical groups of individual machines and groups of machines in the computer network" arranged in trees. The difference between trees and lists – particularly an "access control list" as recited in claim 12 of the present application – is a structural difference between Harsham and claim 12. The Office Action applies no other reference, including Nguyen, that teaches this claim limitation. For this independent reason, the rejection of claim 12 based on Harsham in view of Nguyen is erroneous and must be withdrawn.

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2) **Improper combination of references**:

a) In the "Response to Arguments" section on page 6 of the Office Action, the Examiner asserts that a reason for combining the Harsham and Nguyen references is because "teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." As discussed below, this assertion fails.

Specifically, the Office Action asserts that a person of ordinary skill in the art would be motivated to combine Harsham and Nguyen because Nguyen states that "all types of providers must position themselves for growth and agility to handle increasing numbers of subscribers, additional services, and workloads that are more challenging" (Nguyen at page 3, paragraph [0030]). This generic aspirational statement is insufficient to motivate the proposed combination of these two references because Harsham and Nguyen are fundamentally different. Harsham describes a system for creating logical network topologies aligned with internal business divisions; Nguyen describes a system for setting up an Internet Service Provider (ISP). Even the statement relied upon by the Examiner to justify their combination actually serves to highlight the differences: "handl[ing] increasing numbers of subscribers" is completely inapplicable to Harsham because Harsham's system has no "subscribers"- *every system in Harsham is already internal to the company*. Since a system designed to sell services to subscribers is fundamentally different than a system designed to work inside a single organization, the proposed modification to Harsham would change the principle of operation of Harsham. However, MPEP §2143.01(VI) provides that "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." Thus the Examiner's suggestion to combine these references under §103 in order to achieve this result is improper and constitutes clear error.

Further, Nguyen and Harsham give opposite prescriptions as to how to solve problems of growth and scalability. Specifically, Nguyen states that early ISPs were not able to "scale their systems capacity" because they "combined the few required applications onto a single server" and pursued a "monolithic architecture design," and Nguyen therefore proposes a distributed architecture. Paragraph [0005] and abstract of Nguyen. In contrast, Harsham states that

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"management of very large computer networks that are geographically dispersed is a difficult task" and prescribes a "centralized computer network management system." Harsham, col. 1, ll. 39-41, 48-50.

Thus, Harsham teaches against Nguyen's distributed system, and Nguyen teaches against Harsham's centralized system. Because Harsham and Nguyen have diametrically opposed prescriptions for achieving the purported result of greater "growth and agility," the Examiner's suggestion to combine these references under §103 in order to achieve this result is improper under MPEP §2145 X(D)(2), which provides that "it is improper to combine references where the references teach away from their combination."

Even further, the difference between Nguyen's distributed system and Harsham's centralized system is such that forcing them together would render Harsham's system unsatisfactory for its intended purpose. MPEP 2143.01(V) provides that: "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Centralized and distributed systems are opposites in many respects. Changing Harsham's centralized system into a distributed system in light of Nguyen would remove the manageability advantages associated with centralization, thereby increasing cost and complexity and rendering Harsham's system unsatisfactory for its intended purpose. Thus, the Examiner's suggestion to combine these references under §103 in order to achieve this result is improper and constitutes clear error.

b) Paragraph 11 b) of the present Office Action offers a response to Applicant's argument that "it is improper to combine references where the references teach away from their combination." However, as discussed below, the Examiner's assertions fail.

1) Rejection using two references

The Office Action asserts the "claims were rejected using two references one as a primary reference (Harsham), which teaches mostly and remaining limitation(s) covered the second reference (Nguyen)." This argument does not make logical sense. Saying that the claims

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were rejected using two references does not address the substance of the argument that the combination of those two references was improper.

2) Suggestion in the prior art

The Office Action cites *In re Fielder*, 471 F.2d 640, for the proposition that "a prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested <u>the claimed subject matter</u> to a person of ordinary skill in the art" (italics removed, underline added). However, the Examiner has never shown any "teachings from the prior art itself" that would suggest the claimed subject matter. For example, the Office Action does not show where either Harsham or Nguyen suggests the "rule base," "rule enforcing engine," or "rule insertion engine" of claim 12. Therefore, the Examiner has not met the burden of proof required by the MPEP and *In Re Fielder*. Accordingly, the rejection of claim 12 over the proposed combination of Harsham and Nguyen under §103(a) is improper and must be withdrawn.

Finally, the Office Action itself suggests that "objective evidence of unobviousness" can rebut a prima facie case of obviousness. Applicants agree. However, as discussed above, the Examiner has *not* made a prima facie case of obviousness.

As just one example, MPEP §2145 X(D)(2) provides that: "It is improper to combine references where the references teach away from their combination." The present Office Action suggests that Harsham and Nguyen should be combined because Nguyen states that "all types of providers must position themselves for growth and agility to handle increasing numbers of subscribers, additional services, and workloads that are more challenging" (Nguyen at page 3, paragraph [0030]). As discussed above, however, Nguyen and Harsham give opposite prescriptions as to how to solve problems of growth and scalability. Because Harsham and Nguyen teach away from each other, the Examiner has not established a prima facie case of obviousness. Accordingly, the Office Action's suggestion to combine these references under §103 is improper.

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Thus, for each of these reasons, individually and collectively, it is respectfully submitted that claim 12 is not rendered obvious under §103 by the proposed combination of Harsham and Nguyen, and notice to that effect is respectfully requested.

Rejection of Claim 1 under 35 U.S.C. §103(a)

Claim 1 stands rejected under 35 U.S.C. §103(a) based on a proposed combination of Harsham and Nguyen. This rejection is respectfully traversed.

Specifically, paragraph 4 of the Office Action asserts that Harsham teaches the structural elements recited in claim 1. The Office Action further asserts in the "Response to Arguments" section that the "use of the claimed invention must result in a structural difference between the claimed invention from the prior art."

This assertion is invalid on its face. Claim 1 is a method claim; rejections based upon a supposed lack of structural difference *are not applicable* to method claims. Therefore, the rejection due to a supposed lack of a "structural difference" is a clear error and must be withdrawn. Notice to that effect is respectfully requested.

Further, as stated in MPEP §2143, "To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." Contrary to the assertions of the Examiner, the Harsham and Nguyen references, even when combined, do not teach all elements of claim 1. In particular, Applicants respectfully submit that the Examiner has not shown how either the Harsham reference, the Nguyen reference, or both references together teach all of the claim limitations recited in claim 1. Some of the differences, such as "creating a new independent rule block," "mapped independent rule blocks," an "access control list," and "merging the blocks" have already been discussed relative to claim 12, and that discussion is not repeated here.

As just one additional example, however, claim 1 recites the step of "removing from the set those blocks for which a position cannot be determined." Discussion of this claim language does not appear *anywhere* in the text of the Office Action. It is impossible for the Office Action

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to claim equivalence between claim 1 and any combination of Harsham and Nguyen if the Office Action does not discuss every element of claim 1 as required by MPEP §2143.

Accordingly, the Office Action's proposal to combine these references under §103 is improper under MPEP §2143. Therefore, it is respectfully submitted that claim 1 is not rendered obvious under §103 by the proposed combination of Harsham and Nguyen, and notice to that effect is respectfully requested.

Rejection of Claim 20 under 35 U.S.C. §103(a)

Claim 20 stands rejected under 35 U.S.C. §103(a) based on a proposed combination of Harsham and Nguyen. This rejection is respectfully traversed.

Specifically, paragraph 4 of the current Office Action asserts that Harsham teaches the structural elements recited in claim 20. The Office Action further asserts in the "Response to Arguments" section that the "use of the claimed invention must result in a structural difference between the claimed invention from the prior art."

This assertion does not apply to claim 20. Claim 20 is a Beauregard claim – the structure provided is "a computer readable medium comprising computer-executable instructions." Claim 20 recites the functioning of the instructions to achieve a recited result. As discussed in MPEP §2106.01, the combination of a computer-readable medium and functionally-defined instructions *is* structure. Claim 20 recites "rule blocks" contained in an "access control list." Claim 20 also recites a list as opposed to Harsham's graphs or trees. These are "structural differences" under MPEP §2106.01; therefore, the rejection due to a supposed lack of a "structural difference" is a clear error and must be withdrawn. Notice to that effect is respectfully requested.

Further, and contrary to the assertions of the Examiner, the references, even when combined, do not teach all elements of the claim. As stated in MPEP §2143, "To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." Applicant respectfully asserts that the Examiner has not shown how either the Harsham reference, the Nguyen reference, or both references together teach all of the claim limitations recited in claim 20. Some of the differences, such as "creating a

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new independent rule block," "mapped independent rule blocks," an "access control list," and "merging the blocks" have already been discussed relative to claim 12, and that discussion is not repeated here.

As just one additional example, however, claim 20 recites "computer instructions" including instructions for "removing from the set those blocks for which a position cannot be determined." Discussion of this claim language does not appear *anywhere* in the text of the Office Action. It is impossible for the Office Action to claim equivalence between claim 20 and any combination of Harsham and Nguyen if the Office Action does not discuss every element of claim 20 as required by MPEP §2143.

Accordingly, the Office Action's suggestion to combine these references under §103 is improper under MPEP §2145 X(D)(2). Therefore, it is respectfully submitted that claim 20 is not rendered obvious under §103 by the proposed combination of Harsham and Nguyen, and notice to that effect is respectfully requested.
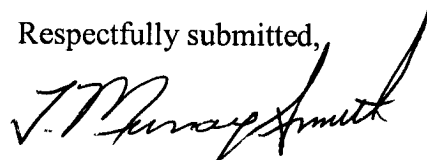
Dependent Claims

Claims 2-3 and 10-11, Claims 13-14 and 18-19, and Claim 21 respectively depend from Claim 1, Claim 12, and Claim 20, and are also believed to be distinct from the art of record, for example for the same reasons discussed above with respect to Claims 1, 12 and 20.

Conclusion

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

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Although Applicants believe that no fees are due in association with the filing of this Response, the Commissioner is hereby authorized to charge any additional fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone LLP.

Respectfully submitted,

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Enclosures: None

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